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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,398	12/28/2001	Kjetil Johannessen	42390P13377	2067

7590 06/14/2005

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EXAMINER

MOONEY, MICHAEL P

ART UNIT	PAPER NUMBER
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2883

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/040,398

Applicant(s)

JOHANNESSEN, KJETIL

Examiner

Michael P. Mooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-27 and 32 is/are allowed.
- 6) ☒ Claim(s) 16, 19 and 28 is/are rejected.
- 7) ☒ Claim(s) 18, 20, 29-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Arguments***

Applicant's arguments filed 3/31/05 have been fully considered but they are not persuasive with respect to claims 16 and 19.

Applicant has added the phrase "or on". The addition of said phrase does not further limit the claim because it is in the alternative.

Horii does indeed teach the limitations necessary to render claim 16 unpatentable.

Additionally, Applicant states in the 3/31/05 Remarks that the discussion regarding claim 21 is relevant for claim 16 in that Horii allegedly does not teach "a first waveguide in or on a bottom portion of the prism, the rounded top to focus light entering the prism into the first waveguide". The fact that Horii does indeed teach a waveguide in a bottom portion of a prism is shown in figure 59 (as stated in the 12/29/04 Office action). The bottom of the prism portion of figure 59 is fused to the waveguide 172 and is in or on a bottom portion of the prism as can be seen in figure 59. Furthermore, it is reasonable to refer to at least a part of the portion that is fused to the waveguide as at least a part of the "bottom portion" of the prism of Horii figure 59. The optical fiber is fused in or on a prism that has a rounded top portion as shown in figure 59. The portion of 176 below the rounded top is inherently a prism.

As described in the 12/29/04 Office action, Horii et al. does indeed teach or suggest all of the claim limitations in the 10/21/04 version of the said claim 16.

Furthermore, Horii et al. does indeed teach or suggest all of the claim limitations in the

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3/31/05 version of the said claim 16. The rejection of claim 16 in the 12/29/04 Office action is proper and the rejection of the 3/31/05 version of claim 16 is also proper.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 16, 28, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horii et al. (6687010).**

Horii et al. teaches a prism having a rounded top (fig. 59; see area around "176" for rounded top; prism is in area below the rounded top); and a 1<sup>st</sup> waveguide 172 in or on a bottom portion of the prism, the rounded top to focus light entering the prism into 1<sup>st</sup> waveguide (fig. 59).

Thus claim 16 is rejected.

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Regarding claim 28, although Horii et al. does not explicitly mention "the prism is at least partially made of sapphire, high density glass,  $\text{LiNbO}_3$ , or rutile" it would have been obvious to do so because it is notoriously well known to use a prism made of one of said materials in an application such as depicted at claim 59.

One of ordinary skill in the art would have been motivated to use one of the said materials as the prism material for the purpose of optimizing optical coupling. Thus claim 28 is rejected.

Horii et al. teaches wherein the light entering the rounded top is capable of being redirected approximately 90 degrees by the prism and the 1<sup>st</sup> waveguide. (fig. 59). Thus claim 19 is rejected.

***Allowable Subject Matter***

Claims 21-27, 32 are allowed.

Claims 18, 20, 29-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art, either alone or in combination, does not disclose or render obvious the unique combination of each and every specific element stated in the claims 21-27, 32, 18, 20, 29-31.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

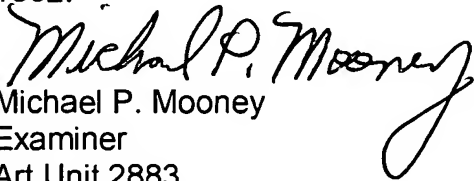
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Mooney whose telephone number is 571-272-2422. The examiner can normally be reached during weekdays, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-

1562.



Michael P. Mooney  
Examiner  
Art Unit 2883



Frank G. Font  
Supervisory Patent Examiner  
Art Unit 2883

FGF/mpm  
6/2/05